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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/349,708	07/08/1999	CHARLES WILLIAM BERTHOUD	BERTHOUD-16-	7016

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FARKAS & MANELLI PLLC
2000 M STREET NW
7TH FLOOR
WASHINGTON, DC 200363307

EXAMINER

BUI, BING Q

ART UNIT PAPER NUMBER

2642

DATE MAILED: 05/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

HS

Office Action Summary

Application No.

09/349,708

Applicant(s)

Berthoud et al

Examiner

Bing Bui

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 12, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 2642

DETAILED ACTION

1. This action is in response to applicant's response filed on Mar 12, 2002. Claims 1-25 are now pending in the present application. **This action is made final.**

Claim Rejections - 35 USC § 102

2. Claims 1-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Norris et al (US Pat No. 5,805,587).

Regarding claim 1, with respect to Figure 1, Norris et al teach the invention as claimed, a system for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but-busy party is accessing the Internet over the same telephone line, comprising:

Internet communication module (Abstract; Figs 4-5 and col 4, ln 6-col 8, ln 5);
and

a message formatter (Abstract; Figs 4-5 and col 4, ln 6-col 8, ln 5);

wherein said Internet communication module is adapted to cause said message formatter to send a notification message to said called-but-busy party upon request of an internet interruption from a remote telephone user (Abstract; Figs 4-5 and col 4, ln 6-col 8, ln 5).

Art Unit: 2642

Regarding claim 2, with respect to Figure 1, Norris et al teach the invention as claimed, an apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, wherein said remote telephone user is a central office (Fig 1, item 50 and col 5, ln 48-col 6, ln 15).

Regarding claim 3, with respect to Figure 1, Norris et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, wherein said remote telephone user is a party trying to establish a telephone call with said called-but-busy party (Abstract; Figs 4-5 and col 4, ln 6-col 8, ln 5).

Regarding claim 4, with respect to Figure 1, Norris et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising:

a call related information receiver (Abstract; Figs 4-5 and col 4, ln 6-col 8, ln 5);
wherein call related information regarding a calling party is included with said notification message (Abstract; Figs 4-5 and col 4, ln 6-col 8, ln 5).

Regarding claim 5, with respect to Figure 1, Norris et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone

Art Unit: 2642

call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, wherein said call related information receiver is a Caller ID receiver (Fig 6 and col 8, ln 20-48).

Regarding claim 6, with respect to Figure 1, Norris et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising: said notification message is a textual message (Fig 6 and col 8, ln 20-48).

Regarding claim 7, with respect to Figure 1, Norris et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 6, wherein said textual message is an e-mail message (Fig 6 and col 8, ln 20-48).

Regarding claim 8, with respect to Figure 1, Norris et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising said notification message includes an audibly playable data file (Fig 6 and col 8, ln 20-48).

Regarding claim 9, with respect to Figure 1, Norris et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone

Art Unit: 2642

call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, wherein said audibly playable data file automatically plays when received on a computer terminal of said called-but-busy party (Fig 6 and col 8, ln 20-48).

Regarding claim 10, with respect to Figure 1, Norris et al teach the invention as claimed, apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising: a data signal detector adapted to detect likely Internet usage of said called-but-busy party (Abstract; Figs 4-5 and col 4, ln 6-col 8, ln 5).

Regarding claim 11, with respect to Figure 1, Norris et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 10, wherein said notification message includes information regarding likely Internet usage of said called-but-busy party (Abstract; Figs 4-5 and col 4, ln 6-col 8, ln 5).

Regarding claim 12, with respect to Figure 1, Norris et al teach the invention as claimed, a method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user, comprising:

Art Unit: 2642

uniquely identifying an Internet user via a telephone call (Abstract; Figs 4-5 and col 4, ln 6-col 8, ln 5); and

notifying said user that said calling party is requesting an internet interruption of said Internet user over said telephone line (Abstract; Figs 4-5 and col 4, ln 6-col 8, ln 5).

Regarding claim 13, with respect to Figure 1, Norris et al teach the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, further comprising receiving a notification request from said calling party (Abstract; Figs 4-5 and col 4, ln 6-col 8, ln 5).

Regarding claim 14, with respect to Figure 1, Norris et al teach the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, further comprising receiving a notification request from a central office (Fig 1, item 50 and col 5, ln 48-col 6, ln 15).

Regarding claim 15, with respect to Figure 1, Norris et al teach the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, further comprising determining at a central office a likelihood that said Internet user is connected with said Internet (Fig 1, item 50 and col 5, ln 48-col 6, ln 15).

Art Unit: 2642

Regarding claim 16, with respect to Figure 1, Norris et al teach the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, wherein said notification is an e-mail message (Fig 6 and col 8, ln 20-48).

Regarding claim 17, with respect to Figure 1, Norris et al teach the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, wherein said notification is a n audibly playable message (Fig 6 and col 8, ln 20-48).

Regarding claim 18, with respect to Figure 1, Norris et al teach the invention as claimed, a method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user, comprising:

determining at a central office a likelihood that said Internet 10 user is connected with said Internet (Fig 1 and col 5, ln 48-col 6, ln 15); and

notifying a n attempted calling party to said Internet user of said likelihood from said central office (Fig 1 and col 5, ln 48-col 6, ln 15).

As to claims 19-22 , they are rejected for the same reasons set forth to rejecting claims 12-15, respectively.

As to claims 23-24, they are rejected for the same reasons set forth to rejecting claims 7-8, respectively.

Art Unit: 2642

As to claim 25 , it is rejected for the same reasons set forth to rejecting claim 18.

Response to Arguments

3. Applicant's arguments filed on Mar 12, 202 have been fully considered but they are not persuasive. .

As to Applicant's Remarks, Applicant mainly argues as follows:

- (1) Norris fails to teach any type of request made to an internet user.
- (2) Norris fails to teach mean for notifying an attempted calling party of a likelihood the Internet user is connected with an internet from a central office.

Examiner respectfully disagrees for the following reasons:

As to part (1), the internet user S1 is notified with a call waiting alerting message that showing the calling party S2 desires to speak to the internet user S1.

As to part (2), while internet user S1 being in an internet session, the calling party S2 receives an announcement for leaving a voice message for internet user S1; as it can be seen by an ordinary skill in the art that the announcement for leaving a voice message is transparently a notification of the unavailability of the called party and as all know the unavailability can be caused by a numerous of reasons such as called party being busy on an ongoing communication connection either in the form of voice or

Art Unit: 2642

data communication such as an internet connection, called party is not physically at his premise, etc.

For the above reasons, the final action is provided herein.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

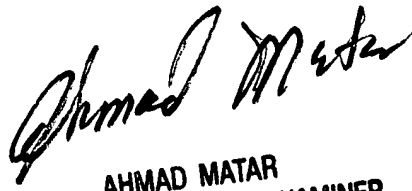
Art Unit: 2642

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bing Bui whose telephone number is (703) 308-5858. The examiner can normally be reached on Monday through Thursday from 7:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314 and for formal communications intended for entry (please label the response "EXPEDITED PROCEDURE") or for informal or draft communications not intended for entry (please label the response "PROPOSED" or "DRAFT").

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

BING BUI
May 17, 2002


AHMAD MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600